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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,463	10/15/2001	William C. Johnson JR.	GEO-55	3692

7590 04/13/2005

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/977,463

Applicant(s)

JOHNSON, WILLIAM C.

Examiner

Anthony Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005, RCE entered.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 13, 2005 has been entered.

### ***Drawings***

2. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5-6 and 8-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims an outer layer of stretched leather,

Art Unit: 3728

which was not disclosed in the specification as originally filed. The specification only discloses an outer layer of stretchable leather, not leather that is already stretched.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over international reference to Techboot WO 92/14372 (WO '372) in view of Herber 5,163,198. WO '372 discloses all the limitations substantially as claimed including the following: a boot (see Figure 2) having an outer layer 35 of leather stretched over an oversized toe box 27 located beneath the outer layer; a layer of compressible cold insulating material 43 secured to the inside of the toe box in an uncompressed state; a lining 34 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 10. WO '372 does not disclose the insulating material being located but not being compressed between the toe box and the lining. Herber 198 teaches that an insulating layer 4 for a toe protected boot can be located, uncompressed, between the toe box 3 and the lining 6 to provide air absorption and cushioning to the user's foot during use. Therefore, it would have been obvious, to one of ordinary skill in the

Art Unit: 3728

art at the time the invention was made, to place an insulating layer between the toe box and the liner of WO '372, as taught by Herber '198, to aid in protecting and cushioning the user's foot while insulating the boot as well.

3. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 in view Herber 5,163,198 as applied above further in view of Applicant's admission of obviousness. WO '372 in view of Herber '198 as applied above disclose all the limitations substantially as claimed except for the thickness of the insulating material. Official Notice was taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness to insulate the boot to the hold the desired temperature. Applicant failed to argue the obviousness of the Official Notice and therefore appears to agree with the obviousness. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of WO '372 the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

4. Claims 1, 5, 6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over White 3,805,419 or Adams 4,102,062 in view of WO 92/14372 and Herber 5,163,198.

White '419 disclose all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 8 stretched over an oversized toe box 1 located beneath the outer layer; a layer of compressible cold insulating material 5 secured to the inside of the toe box in an uncompressed state (fastened to sole therefore not compressing uncompressed layer 5 to toe cap); a lining 6 extending below the compressible cold insulating material so that the cold

Art Unit: 3728

insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 9.

Adams '062 discloses all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 11 stretched over an oversized toe box 13 located beneath the outer layer; a layer of compressible cold insulating material 25 secured to the inside of the toe box in an uncompressed state (fastened to sole and not shown compressed between liner and toe box); a lining 24 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 14.

Neither White '419 nor Adams '062 discloses the outer layer being leather or the thickness of the insulating layer. WO '372 teaches that a leather exterior boot can have a toe box, insulating layer and lining located beneath the outer leather layer of a work boot to aid in insulating the user's foot from cold weather. Therefore, it would have been obvious, in view of WO '372, to make the boot used in each of White '419 or Adams '062 out of leather, as taught by WO '372, to aid in protecting the user's foot from impacts. Herber '198 teaches that an insulating layer 4 for a toe protected boot can be located, uncompressed, between the toe box 3 and the lining 6 to provide air absorption and cushioning to the user's foot during use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an insulating layer between the toe box and the liner of WO '372, as taught by Herber '198, to aid in protecting and cushioning the user's foot while insulating the boot as well.

With respect to the limitations of the thickness of the insulating layer, Official Notice was taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness necessary to insulate the boot to hold the desired temperature. Applicant failed to argue the obviousness of the Official Notice and therefore appears to agree with the obviousness. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of WO '372 the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

5. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above. Since the toe boxes of the references as applied above are intended to cover different sized shoes, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to vary the size of the toe box to fit the size of the shoe being used, including a height of 1.9 inches and a length of 2 inches, so that the foot within the shoe is properly protected.

### ***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. With respect to applicant's arguments that WO '372 does not disclose the leather outer layer, this argument is not clearly understood. Clearly, WO '372 teaches the use of leather as an exterior layer as noted and designated by reference number 35.

### ***Conclusion***

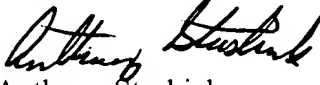
Art Unit: 3728

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561.

The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS